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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,603	04/16/2001	Satoru Todo	067242/0148	2083

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EXAMINER

KWON, BRIAN YONG S

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 11/15/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,603

Applicant(s)

TODO, SATORU

Examiner

Brian-Yong S Kwon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group (A), claims 1-34^A, drawn to a composition containing sPLA2 inhibitor represented by formula (I)-(XXIII).

Group (B), claims 40-53, drawn to a method of use with said composition.

The inventions listed as Groups A and B do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature linking groups A and B appears to be that they all relate to a sPLA2 inhibitor represented by formula (I)-(XXII). However, the claimed compounds represented by formula (I)-(XXIII) are known in the art (EP 675110; US 5654326; US 5641800; EP 620214; (Draheim et al., J. Med. Chem. (1996), 39(26), 5159-5175); EP 675110; EP-620215; EP-675110; WO 96/03120; WO 9603376; WO 9603383; WO 9721664; WO 9721716; WO 9818464; WO 9824437; Wo 9824756; WO 9824794; WO 9825609; US 5436258; US 5532366; US 5719149; US 5807829; US 5807829; US 5453443; EP 887342; WO 9847507; WO 9842343; WO 9837069). Therefore, the technical feature linking the inventions of groups A-B does not constitute a special technical feature as

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defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Accordingly, Groups A and B are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

2. If the applicant elects Group (A) invention, it is subject to further restriction as followings because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 as reasoned above.

Group I, claim(s) 3-7, 33, drawn to a composition comprising formula (I)-(V).

Group II, claim(s) 8-11, drawn to a composition of formula (VI), (VII), (VIII) and (IX).

Group III, claim(s) 12-13, drawn to a composition of formula (X)-(XI).

Group IV, claim(s) 14-15, drawn to a composition of formula (XII).

Group V, claim(s) 16, drawn to a composition of formula (XIII).

Group VI, claim(s) 17, drawn to a composition of formula (XIV).

Group VII, claim(s) 18, drawn to a composition of formula (XV).

Group VIII, claim(s) 19, drawn to a composition of formula (XVI).

Group IX, claim(s) 20, drawn to a composition of formula (XVII).

Group X, claim(s) 21, drawn to a composition of formula (XVIII).

Group XI, claim(s) 22-23, drawn to a composition of formula (XIX)-(XX).

Group XII, claim(s) 24-25, drawn to a composition of formula (XXI)-(XXII).

Group XIII, claim(s) 26-27, drawn to a composition of formula (XXIII).

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3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 as discussed above.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added.

4. With the election of a specific exemplified compound, a generic concept will be identified by the examiner as the inventive group for examination.

5. A telephone call was made to Stephen B. Maebius on September 24, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (703) 308-5377. The examiner can normally be reached Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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Brian Kwon

ZOHREH FAY
PRIMARY EXAMINER
GROUP 1600

A handwritten signature in black ink, appearing to read 'Zohreh Fay', with a stylized flourish at the end.